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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,537	01/03/2002	Robert J. Reiter	SACHP0140US	7095

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EXAMINER

PHASGE, ARUN S

ART UNIT PAPER NUMBER

1753

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,537

Applicant(s)

REITER ET AL.

Examiner

Arun S. Phasge

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-17, 19-24, 26-31, 33-37 is/are rejected.
- 7) ☒ Claim(s) 8, 18, 25 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 34-37 stand rejected under 35 U.S.C. 102(b) as being anticipated by Hulme of record for reasons of record.

The Hulme patent discloses the claimed product (see abstract).

Claims 34-37 stand rejected under 35 U.S.C. 102(b) as being anticipated by Moulton of record for reasons of record.

The Moulton patent discloses the claimed product (see abstract).

Therefore, since the prior art clearly discloses the claimed product of an aqueous solution of purified quaternary ammonium hydroxide, the claims are anticipated.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moulton of record for reasons of record in view of Hulme.

The Moulton patent is applied as in the prior Office action. Moulton, while disclosing that one having ordinary skill in the art would find it readily apparent

that additional numerous embodiments not specifically described in the figures exist within the scope of the invention, does not disclose that the second bipolar membrane and the cathode form the compartment adjacent to the cathode.

The Hulme patent is cited to show that such an arrangement of first and second bipolar membranes and cation membrane, wherein the compartment adjacent to the cathode is formed by the second bipolar membrane and the cathode (see figure 5).

Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Moulton patent with the teachings of the Hulme patent, because the Hulme patent discloses that such an arrangement of membranes allows the formation of a purified solution of onium hydroxide.

Claims 12-21 and 28-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moulton in view of Shay of record for reasons of record.

Response to Arguments

Applicant's arguments with respect to claims 1-11, 22-27 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 12/15/03 with respect to claims 12-21, 28-37 have been fully considered but they are not persuasive.

Applicants argue that there is no basis for combining the teachings of the Moulton and Shay references, since the Moulton patent teaches the purification of onium hydroxides and the Shay patent teaches an electrochemical cell utilized to produce onium hydroxides from onium salts.

The Moulton patent does not merely disclose the purification of onium hydroxides, but rather it discloses the equivalent steps used to purify onium hydroxides and/or form onium hydroxides from onium salts (see col. 6, lines 53-56).

Applicants further argue against the combination of the Moulton and Shay patents, because the feed compartment is formed between two different membranes for each respective reference.

In response to applicant's argument above, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of

ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Moulton patent discloses a variety of feed compartment formed between a variety of membranes, including the types of feed chambers disclosed in the Shay patent (see figures 1-7 of Moulton and figures 1-6 of Shay).

Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Moulton patent in view of Shay patent, because the Shay patent teaches the particular arrangement of membranes as presently claimed to form onium hydroxide.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

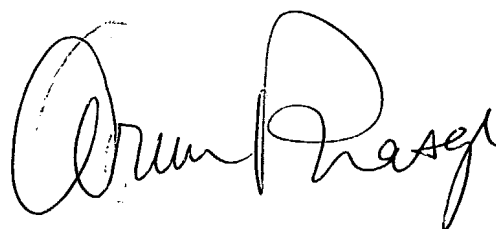
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the

advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (571) 272-1345. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Arun Phasge', with a large, stylized initial 'A'.

Arun S. Phasge
Primary Examiner
Art Unit 1753

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